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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,301	11/17/2003	Setsu Mitsuhashi	117789	1100
25944 7590 12/09/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
VIG, NARESH				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
12/09/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarnstrong@oliff.com

### Office Action Summary

**Application No.**

10/713,301

**Applicant(s)**

MITSUHASHI ET AL.

**Examiner**

NARESH VIG

**Art Unit**

3629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 14 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 14 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8506)  
Paper No(s)/Mail Date 2010-1012, 0729, 0729, 0908.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is in reference to communication received 24 September 2010, Addition of claim 26 is acknowledged. Claims 1 - 3, 5, 14 and 26 are pending for examination.

### ***Response to Arguments***

Applicant's arguments and concerns are for amended claims and newly added claim which have been responded to in response to pending claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 – 3, 5, 14 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being vague to determine the scope of the claimed subject matter which applicant regards as the invention.

As currently claimed, it is not clear how the system determines whether the user who has requested to include an image stored in the electric album service in the message when the user has not created any message. As currently claimed, user is only provided with a screen to prepare a message to be carried by the bulletin board.

In addition, applicant recites:

the system displaying images stored in the electric album service on the screen;

the system determining whether the user has requested to include an image stored in the electric album service in the message;

the system determining, whether the stored setting of the requested image indicates that the requested image is permitted to be browsed by a third party when the user has requested to include an image stored in the electric album service in the message.

As currently claimed, it is not clear whether the user is only displayed the images they own or co-own or authorized by the owner of the image, or, said user is displayed with all the images on the system (in this case user is a third party user), or, something else.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 3, 5, 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikugawa US Publication 2007/0050459 in view of Watanabe US Patent 6,578,072.**

Regarding claim 1, Kikugawa teaches capability and concept of system and method for an Electronic Bulletin Board which communicates with users and plurality of servers [Kikugawa, Fig. 1 and disclosure associated with the figure]. Kikugawa teaches capability and concept for associating links/URLs to additional information embedded with the text (Kikugawa, Fig. 4 and disclosure associated with the Figure). Kikugawa does not explicitly recite protecting the contents provided by the user by providing the access to contents to authorized users. However, Watanabe teaches capability and concept of system and method for online digital photographic service. Watanabe teaches that digital images are disclosed on a network only to persons that a user to browse through the images [Watanabe, col. 2, lines 26 - 27].

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Kikugawa by adopting teachings of Watanabe permit browsing of images by authorized third party like visitors to protect the privacy of the user providing the image; to protect the digital content from unauthorized use; provide copyright protection; apply a known technique to a known device (method, or product) ready for improvement to yield predictable results; known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.

Kikugawa in view of Watanabe teaches concept and capability for:  
providing an electric bulletin board service [Kikugawa, 0019, Fig. 2 and disclosure associated with the Figure], a bulletin board of which can carry messages

from users and that works with an electric album service (using the URL capability of Kikugawa), the electric album service providing a storage area for images [Watanabe, Fig. 1, 3 and disclosure associated with the Figure], the electric bulletin board service and the electric album service being provided by a system including one or more servers [Kikugawa 0019 in view of Watanabe, Fig. 1, 3, 6, 7 and disclosure associated with the Figure];

the system storing images in a storage area of an electric album service registered with a user, each image being stored with a setting indicating whether the image is permitted to be browsed by a third party [Watanabe, Fig. 1, 3, 6, 7 and disclosure associated with the Figure];

the system displaying a screen for the user to prepare a message to be carried by the bulletin board [Kikugawa, 0022, Watanabe, Fig. 8 and disclosure associated with the Figure];

the system displaying images stored in the electric album service on the screen [Watanabe, Fig. 6, 7 and disclosure associated with the Figure];

the system determining whether the user has requested to include an image stored in the electric album service in the message [Watanabe, Fig. 6, 7 and disclosure associated with the Figure];

the system determining, whether the stored setting of the requested image indicates that the requested image is permitted to be browsed by a third party when the user has requested to include an image stored in the electric album service in the message [Watanabe, col. 2, lines 26-27],

the system including the requested image as an included image with the prepared message in the bulletin board only when the stored setting of the requested image indicates that the requested image is permitted to be browsed by the third party [Watanabe, col. 2, lines 26-27]; and

the system banning the requested image from being included in the prepared message in the bulletin board when the stored setting of the requested image indicates that the requested image is not to be permitted to be browsed by the third party (**it would have been obvious to one of ordinary skill in the art that an alternate is taken when the comparison test results are not true**) [Watanabe, col. 2, lines 26-27].

Regarding claim 2, Kikugawa in view of Watanabe teaches capability and concept wherein:

the included image can be stored in a different storage area from a storage area provided for the electric album service [Kikugawa, 0019]; and

a link portion is provided on a display screen of the bulletin board to include the included image with the message and the included image is accessed through the display screen of the bulletin board when the link portion is clicked on (**it is old and known to one of ordinary skill in the art that when a link is activated, information is retrieved from the location specified in the link and displayed to the user activating the link**) [Watanabe, Fig. 6-8 and disclosure associated with the Figure].

Regarding claim 3, Kikugawa in view of Watanabe teaches capability and concept wherein the included image can a thumbnail image based on an original image stored in a storage area provided for the electric album service, and the thumbnail image is displayed in a page of the electric album [Watanabe, Fig. 6-8 and disclosure associated with the Figure].

Regarding claim 5, Kikugawa in view of Watanabe teaches capability and concept wherein:

the included image can be a contracted image based on an original image stored in a storage area provided for the electric album service [Watanabe, Fig. 6-8 and disclosure associated with the Figure];

a link portion to display the original image of the is provided on a display screen when the contracted image is displayed on the display screen of the bulletin board [Watanabe, Fig. 6-8 and disclosure associated with the Figure]; and

the original image is read out from the storage area provided for the electric album service and displayed in the bulletin board when the link portion is clicked on [Watanabe, Fig. 6-8 and disclosure associated with the Figure].

Regarding claim 14, Kikugawa in view of Watanabe teaches capability and concept wherein when the user requests an order to erase an original image of the included image, the original image being stored in the storage area provided for the electric album service, and the original image can be erased, and the included image is



not erased (**it would have been obvious to one of ordinary skill in the art that when a owner of the information wants to remove the information stored on a storage device, said information is erased from the storage medium, however, owner of the image does not have authority to write on the storage medium of the other device or users**).

Regarding claim 26, Kikugawa in view of Watanabe teaches capability and concept wherein when the system bans the requested image from being included in the bulletin board, a link portion through which the image is accessed is not provided on a display screen of the bulletin board (**it would have been obvious to one of ordinary skill in the art that an alternate is taken when the comparison test results are not true**) [Watanabe, col. 2, lines 26-27].

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Charles Robinson Article My Twin Days 1999 Photo Album which shows comments can be attached with the Photos, and active links can be provided with the Message to retrieve information from the address in the link when the link is activated by an user.
2. Kopp et al. article Developments in Copyright Policy and Network Technologies

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jamisue Plucinski can be reached on (571) 272-6811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 5, 2010

/Naresh Vig/  
Primary Examiner, Art Unit 3629